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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,175	06/04/2001	Hiromu Ueshima	174.030	9628
38245 7590 02/08/2011 JEROME D. JACKSON (JACKSON PATENT LAW OFFICE) 211 N. UNION STREET, SUITE 100 ALEXANDRIA, VA 22314				
EXAMINER				
BRIER, JEFFERY A				
ART UNIT		PAPER NUMBER		
2628				
NOTIFICATION DATE		DELIVERY MODE		
02/08/2011		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@japalaof.com

**Office Action Summary****Application No.**

09/856,175

**Applicant(s)**

UESHIMA ET AL.

**Examiner**

Jeffery A. Brier

**Art Unit**

2628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 January 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-47 and 52-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-47 and 54-57 is/are allowed.
- 6) ☒ Claim(s) 52, 53, 58 and 59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 10/20/2003 fails to fully comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed and further fails fully to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Therefore, reference AM, a Japanese Office Action, has been lined through because an English language translation or explanation of the Japanese Office Action was not provided with the information disclosure statement.

### ***Response to Amendment***

2. The amendment filed on 01/11/2011 has been entered. The amendments to the claims overcome the 35 USC 112 issues set forth in the office action mailed on 09/01/2010. The amendments to the specification overcome the objections to the specification set forth in the office action mailed on 09/01/2010.

### ***Response to Arguments***

3. Applicant's arguments filed 01/11/2011 have been fully considered but they are not persuasive.

The arguments concerning the prior art rejection of claims 52 and 53 are not persuasive because "said second signal" can be any signal since the apparatus claim limitations before the "said program causing said game processor to:" claim limitation are considered to be in the preamble and are not required to produce "said second signal", therefore, previous art rejection still applies to claims 52 and 53.

The arguments concerning the prior art and claims 58 and 59 have been considered, however, those arguments are not applicable to these claims because these claims are indefinite and non-statutory in view of guidance given in MPEP 217305(p)II.

#### **2173.05(p) Claim Directed to Product-By-Process or Product and Process[R-5]**

##### **II.PRODUCT AND PROCESS IN THE SAME CLAIM**

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. \* > IPXL Holdings v. Amazon.com, Inc., 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005); < Ex parte Lyell, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990) \* > (< claim directed to an automatic transmission workstand and the method \* of using it \* held \*\*ambiguous and properly rejected under 35 U.S.C. 112, second paragraph >) <.

Such claims \* > may < also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which

is drafted so as to set forth the statutory classes of invention in the alternative only. Id. at 1551.

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2100-230

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 58 and 59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each of these claims claim in a single claim both an apparatus and the method steps of using the apparatus which has been held to be indefinite. MPEP 217305(p)II.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 58 and 59 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Each of these claims claim in a single claim both an apparatus and the method steps of using the apparatus which has been held to be non-statutory. MPEP 217305(p)II.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 52 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Lipps et al. US Patent No. 5,741,182.

The limitations of these two claims defining the ball game apparatus, see claim 52 at lines 2-13 and claim 53 at line 2-11, are considered to be intended use of the program. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The limitations of these two claims defining the ball game apparatus, see claim 52 at lines 2-13 and claim 53 at line 2-11, are considered to be in the preamble of these information storage medium claims. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The program and game processing functions of these claims, claim 52 at lines 18-25 and claim 53 at lines 16-22, with regard to Lipps et al. alone were previously addressed in the Final Rejection mailed on 06/18/2009 at pages 8, 26, and 27 and are hereby incorporated by reference. Thus, Lipps et al. anticipates claim 52 at lines 18-25 and claim 53 at lines 16-22 for the previous reasons of record.

***Allowable Subject Matter***

10. Claims 26-47 and 54-57 are allowed.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A. Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:30 to 4:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xiao Wu can be reached at (571) 272-7761. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffery A. Brier/  
Primary Examiner, Art Unit 2628